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PATENT

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Application of Clemente et al.

Serial No. 09/921,068

Filed August 2, 2001

Confirmation No. 5827

For DOWN-REGULATION OF SINGLE GENES AND SIMULTANEOUS DOWN-
REGULATION OF MULTIPLE GENES BY NUCLEAR LOCALIZATION OF RNA
TRANSCRIPTS

Examiner S. McGarry

Art Unit 1635

TECH CENTER 1600/2900

April 22, 2003

RESPONSE TO RESTRICTION REQUIREMENT

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action mailed March 13, 2003, the time for response to which is extended to May 13, 2003, by the attached payment of the fee required under 37 C.F.R. §1.136(a), in which an election between Group I, drawn to claims 1-6, Group II, directed toward claims 7-15, Group III, drawn to claims 16-26, and Group IV, directed toward claims 16-20 and 27-40, for prosecution on the merits was requested.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of an entire application can be made **without serious burden**, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."¹

In this case, restriction is not proper. Group I and Group II claims are both drawn to a method of suppressing gene expression in a eukaryotic cell. One step of each method employs the use of a recombinant vector comprising a sense nucleotide sequence of a gene to be suppressed (Group I claims) or a vector comprising an antisense nucleotide sequence of a gene to be suppressed (Group II). Groups III and IV claims are directed toward the recombinant vector (or cells having the vector of Group I or Group II) employed in the method of the Group I or Group II claims. Any search of the prior art and examination involving Group I claims will necessarily co-

¹ MPEP § 803 (emphasis added).

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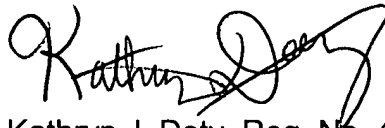
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extend with the search and examination of Group II claims and will also necessarily co-extend with the search and examination of Group III and Group IV claims. Further, the prior art regarding methods of gene suppression in eukaryotic cells employing vectors having a sense or antisense nucleotide sequence of the gene to be suppressed is sufficiently sparse to allow the examination of these claims without undue burden. Thus, as the examination of the entire application may be made without serious burden, Groups I, II, III and IV claims should be examined together in accordance with MPEP § 803.

Applicants, subject to the foregoing traverse, elect to prosecute Group I, claims 1-6.

Respectfully submitted,



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